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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,198	09/24/2003	Minoru Terano	2003_1361	4120
513	7590	03/08/2004	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			TESKIN, FRED M	
2033 K STREET N. W.			ART UNIT	
SUITE 800			PAPER NUMBER	
WASHINGTON, DC 20006-1021			1713	

DATE MAILED: 03/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

A2

Office Action Summary	Application No. 10/668,198	Applicant(s) TERANO ET AL.	
	Examiner TESKIN	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 32-57 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-10 and 32-55 is/are allowed.
- 6) ☒ Claim(s) 11-24, 56 and 57 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>092403</u> . | 6) <input type="checkbox"/> Other: ____. |

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The preliminary and supplemental preliminary amendments of September 24, 2003 and February 18, 2004 have been entered in full. Claims 1-24 and 32-57 are currently pending and under examination in this continuation application of prior pending application no. 09/807,842.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 103(c) and potential 35 U.S.C. 102 (e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 11-24, 56 and 57 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 6211300 to Terano et al.

Terano exemplifies propylene-ethylene block copolymer compositions (E) which contain an A-B type block copolymer (C) of polypropylene (A) and an ethylene-propylene random copolymer (B) and a propylene polymer (D), and wherein the content of said copolymer segment and the total ethylene content [(C) plus (D)] meet the corresponding parameters of independent claims 11 and 18. In addition, Terano states that the segment (B) is chemically bonded to the polypropylene segment (A), per characteristic (a) of claim 18, and describes a procedure for synthesizing the (A) and (B) segments using a catalyst component which corresponds to the procedure and catalyst component recited as characteristic (b) of claim 18. See column 2, lines 32-44 and Examples 1-13 in Tables 1-5.

With respect to claim 18, the exemplified compositions of Terano are seen to meet all the positive compositional limitations of claim 18 as well as the recited characteristics (a) and (b). Furthermore, composition (E) of Terano, like the claimed polypropylene resin, is characterized as transparent (see col. 1, line 10). The "blushing-resistant" property recited in claim 18 but not mentioned by Terano is reasonably presumed to inhere in the exemplified compositions that otherwise meet the compositional and preparational parameters of claim 18.

Moreover, both claim 11 and claim 18 are construed as readable on polymer (D) of the Terano composition in view of the open transitional language, i.e., "propylene-

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ethylene block copolymer *containing ...* " (claim 11, line 1) and "... polypropylene resin for molding *containing ...*" (claim 18, line 1).

Further as to claim 11, the exemplified compositions of Terano meet the claim limitations as to content of poly(ethylene-co-propylene) segment content and ethylene content, but Terano is silent as to molecular weight distribution index (Mw/Mn ratio) and content of xylene-soluble component in the copolymer.

The claimed amount of xylene-soluble component is, however, attributable to the same structural characteristic found in the Terano composition, i.e., the presence of polypropylene segments and poly(ethylene-co-polypropylene) being linked chemically in the propylene-ethylene block copolymer of the present invention (see page 23, bridging paragraph of the present specification and cf. Terano at column 3, lines 10-18).

Accordingly, Terano's composition is reasonably presumed to intrinsically possess an amount of xylene-soluble component from the propylene-ethylene block copolymer (C) and a ratio of ethylene-propylene random copolymer segments (B) remaining after xylene extraction at 20°C within the recitations of claim 11.

As to the claimed molecular weight parameters, Terano does not give values for molecular weight distribution or weight-average molecular weight (Mw).

However, Terano does report melt flow rate (MFR) for the compositions exemplified therein. See the MFR values disclosed in Tables 1-5 of Terano.

Applicants' propylene-ethylene block copolymer is likewise characterized by, *inter alia*, MFR, measured under the same conditions employed by Terano (cf. specification, page 45 paragraph (10) and col. 9, lines 1-2 of Terano). This property is well known in the art

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as being inversely proportional to molecular weight, i.e., MFR decreases with increasing molecular weight. Comparison of applicants' Example I-7 (MFR = 25; see page 53) and Examples 6-10 of Terano (MFR = 21, 20, 20, 21 and 28; see Tables 3 and 4) reveals the close proximity in MFR that exists between embodiments of the claimed invention and the Terano composition. Based on the proximate MFR values, a plausible basis exists for concluding that at least these embodiments of Terano will inherently possess a Mw within claim 11.

Further, in view of the identity of both block copolymer composition and synthesis procedure, examiner has reasonable basis to believe the disclosed compositions of Terano are the same as, or only slightly different from applicants' block copolymer and resin as claimed.

Since this situation involves a 102(e)/103(a) rejection where the property or characteristic relied upon for patentability may be inherent in the prior art, and since the Office does not have facilities to make and test claimed and prior art products, the burden properly shifts to applicants to show that the property or characteristic recited in the claims represents an unobvious difference. *In re Best*, 195 USPQ 430 (CCPA 1977).

Applicants' arguments filed in the supplemental preliminary amendment have been fully considered but are not persuasive of patentability.

Contrary to applicants' contention, the references discussed on page 4 of the present specification do not refute the examiner's position regarding identity of molecular weight between the claimed invention and Terano.

First of all, the discussion gives no indication how the block copolymers disclosed by the cited references were prepared, e.g., whether they were synthesized in the same manner as the exemplified compositions of Terano. The examiner's position respecting molecular weight parameters is based not only on correspondence in block copolymer composition, but on similarity in synthesis procedure and polymerization catalyst between the claimed invention and Terano.

Further as to molecular weight, the proximity in MFR values between embodiments of applicants' block copolymer and Terano's composition (E) is seen to support an inference of identical or similar Mw parameters, for the reasons detailed above.

Claims 1-10 and 32-55 are allowable over the prior art of record.

This is a continuation of applicant's earlier Application No. 09/807,842. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FMTeskin/02-28-04


FRED TESKIN
PRIMARY EXAMINER
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